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REMARKS/ARGUMENTS

Claims 1-21 are pending in this application.

Applicants note that the claims as originally presented did NOT include a claim 19. Accordingly, originally numbered claims 20-22 have been renumbered as claims 19-21, and are referred as renumbered in following remarks.

Claims 1-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ichikawa et al. (U.S. 5,815,900) in view of Hayes et al. (U.S. 5,707,684). Applicants respectfully traverse this prior art rejection.

Claim 1 has been amended to recite:

"A method for adjusting the frequency of an electronic component device, the method comprising the steps of:
providing an electronic component device having an electrode disposed on a surface thereof;
etching the electrode disposed on the surface of the electronic component device by irradiating an ion beam on the electrode; wherein
the ion beam irradiation is performed while moving at least one of the electronic component device and the ion beam in at least one direction along the surface of the electronic component device on which the electrode is disposed." (emphasis added)

Claim 13 recites method steps and features that are similar to the method steps and features recited in claim 1, including the emphasized features.

The Examiner acknowledged that Ichikawa et al. fails to teach or suggest "that the ion beam irradiation is performed while moving at least one of the electronic component device or the ion beam in at least one direction along the surface of the electronic component device on which the electrode is disposed." However, the Examiner alleged that Hayes et al. teaches (Figs. 5; Col. 1, lines 41-51; and Col. 7, lines 7-24) "a method for producing micro-optical components including ion etching performed which moving the electronic component device in at least one direction along the surface of the electronic component device on which the electrode is disposed." Thus, the Examiner concluded that it would have been obvious to "substitute the

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method for producing micro-optical components of Hayes et al. into the method for adjusting the frequency of an electronic component device of Ichikawa et al. in order to minimize variations in etching when ion beam etching is performed on the electrode of the electronic component in order to achieve highly accurate frequency adjustment.” Applicants respectfully disagree.

In contrast to the Examiner’s allegations and the present claimed invention, Hayes et al. does **NOT** teach or suggest that “the ion beam irradiation is performed while moving at least one of the electronic component device and the ion beam in at least one direction along the surface of the electronic component device on which the electrode is disposed.”

Col. 1, lines 41-51 of Hayes et al. discloses various methods for fabricating micro-optic components including ion beam etching with Si. Col. 1, lines 41-51 fails to teach or suggest any specific method steps or techniques, and certainly fails to teach or suggest “the ion beam irradiation is performed while moving at least one of the electronic component device and the ion beam in at least one direction along the surface of the electronic component device on which the electrode is disposed” as recited in the present claimed invention.

Col. 7, lines 7-24 of Hayes et al. refers to an X-Y alignment stage that is used **BEFORE** the optics jet dispensing system 310 is used, to accurately position the fiber optic bundle 318 below the optics jet dispensing system 310 so that drops 322 of liquid optical material accurately land on ends of the fiber optic bundle. Col. 7, lines 7-24 of Hayes et al. fails to teach or suggest anything at all about performing ion beam irradiation while moving the electronic component device or the ion beam **DURING** processing, as alleged by the Examiner, and certainly fails to teach or suggest “the ion beam irradiation is performed while moving at least one of the electronic component device and the ion beam in at least one direction along the surface of the electronic component device on which the electrode is disposed” as recited in the present claimed invention.

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In addition, Hayes et al. is related to applying liquid optical materials. Hayes et al. fails to teach or suggest that the process and equipment disclosed therein could or should be used in a method for adjusting the frequency of an electronic component device. In fact, Hayes et al. teaches or suggests absolutely nothing at all about adjusting the frequency of an electronic component device.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987). Since Hayes et al. fails to teach or suggest that the method disclosed therein could or should be used in a method for adjusting the frequency of an electronic component device, there would have been absolutely no motivation to combine the alleged teachings of Hayes et al. with Ichikawa et al.

The Examiner alleged that the motivation to combine the teachings of Hayes et al. with Ichikawa et al. would have been "to minimize variations in etching when ion beam etching is performed on the electrode of the electronic component in order to achieve highly accurate frequency adjustment." However, as noted above, Hayes et al. fails to teach or suggest anything at all about adjusting the frequency of an electronic component device. Thus, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness since the references offer no suggestion of the claimed combination. See In re Nielson, 816 F.2d 1567, 2 USPQ 2d 1525, 1528 (Fed. Cir. 1987).

Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art

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to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Accordingly, Applicants respectfully submit that Ichikawa et al. and Hayes et al., applied alone or in combination, fail to teach or suggest the unique combination and arrangement of method steps and features recited in claims 1 and 13 of the present application.

In view of the foregoing remarks, Applicants respectfully submit that claims 1 and 13 are allowable. Claims 2-12 and 14-21 depend upon claims 1 and 13, respectively, and are therefore allowable for at least the reasons that claims 1 and 13 are allowable.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

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Attorneys for Applicants

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080